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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,725	11/08/2005	Akihisa Matsumoto	070759-0029	8997
20277 7590 07/11/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER PAREKH, NITIN	
			ART UNIT 2811	PAPER NUMBER
			MAIL DATE 07/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,725	Applicant(s) MATSUMOTO ET AL.	
	Examiner Nitin Parekh	Art Unit 2811	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-30-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

1. Applicant's election of Embodiment 3, claims 1-8 without traverse is acknowledged.

Claim Objections

2. Claim 6 is objected to because of the following informalities:
 - A. Limitations "formed by bending" as recited in claim 6, line 1, should read "bent along".Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Gramann et al. (US Pat. 5907151).

Regarding claims 1-4, Gramann et al. disclose a light emitting element/chip (LEE/LEC) , comprising:

- a box-shaped case/carrier (see 7 in Fig. 6/7) formed out of an insulating material (Col. 7, line 48, Col. 5, line 64) and having a recessed/hollow portion (8 in Fig. 6/7) inside;
- lead metallization in a form of a lead frame terminals/tracks (12/13/16/17 in Fig. 6/7; Col. 7, lines 50-55; Col. 5, lines 43-48) formed out of a conductive material and fixed in the case/carrier; and
- the lead metallization/lead frame terminals (LFT) comprising a first LFT (12/17 in Fig. 6/7) on which the LEE/LEC is fixed and a second LFT (13/16 in Fig. 6/7) connected to the LEE/LEC by wire bonding (26 in Fig. 6/7) and the LEE/LEC fixed on the lead frame, wherein the lead frame metallization has slanted/rise/bent portions (see 12 and 13 in sidewalls of the recess/pit in Fig. 6/7; Col. 7, lines 50-55) so as to be located on inside/inner side wall surfaces of the case/carrier

(Fig 6 and 7; Col. 7, line 45- Col. 8, line 5; Col. 5-87).

Regarding claim 2, forming the rise portion do not distinguish over , Gramann et al., because only the final product/structure is relevant, not the method of forming the rise portion using “bending”, “pressing”, “stamping”, etc. Note that a “product by process” claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); and In re

Marrosi et al., 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not . Note that applicant has the burden of proof in such cases, as the above case law makes clear. See also MPEP 706.03(e).

Allowable Subject Matter

5. Claims 5-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and the claim objections set forth above.

Reasons for Allowance

6. The following is an examiner’s statement of reasons for allowance:

The references of record do not teach the limitations “a lead frame formed out of a conductive material and fixed in the case; and a light emitting chip fixed on the lead frame, wherein the lead frame has a rise portion formed along an inner surface of a side wall of the case” and “wherein the hollow portion is surrounded by four side walls, and wherein the rise portion is formed along at least three of the side walls” in a light emitting element mounted on a lead frame fixed in a hollow case having four side walls.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nitin Parekh whose telephone number is 571-272-1663. The examiner can normally be reached on 09:00AM-05:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Gurley can be reached on 571-272-1670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAN or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAG system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

NP

/Nitin Parekh/

7-7-08

Primary Examiner, Art Unit 2811

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